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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,280	08/27/2003	Akira Mizuta	Q76402	4443

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/648,280	Applicant(s) MIZUTA, AKIRA	
	Examiner Patricia L. Nordmeyer	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 4-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Repeated Rejections

1. The 35 U.S.C. 103 rejection of claims 1 – 3 over Shigetomi et al. in view of Liu et al. in the paper dated September 26, 2005 is repeated for reasons of record as the arguments presented in the response dated January 26, 2006 are found to be unpersuasive.

New Rejections

Election/Restrictions

2. Newly submitted claim 12 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the method of producing an optical disk using the cover sheet package.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 12 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not

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described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Both claims contain the terminology of “an attaching surface”, which is not supported by the drawings or the specification. There is no mention of the terminology in the specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “an attaching surface” in claims 10 and 11 is unclear, which render the claims vague and indefinite. It is unclear from the drawings and specification what is meant by “an attaching surface” as neither the drawings nor the specification refer to a surface of in the formed article by the terminology.

Correction/clarification is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shigetomi et al. in view of Liu et al.

Shigetomi et al. disclose a cover sheet package (Column 1, line 6) comprising a thin film cover sheet including a resin film (Column 2, lines 22 – 29), the thin film cover sheet having an adhesive film formed on one side surface of the resin film (Column 2, lines 62 – 65), and which is adhered via the adhesive film to a recording surface a disk substrate of an optical disc (Column 1, lines 6 – 7); a peeling sheet which is peelably adhered on a surface of the adhesive film of the cover sheet and which is peeled before the cover sheet is adhered to the recording surface of the disk substrate (Column 3, lines 51 – 57); and a protective sheet which is peelably adhered on a surface of the resin film of the cover sheet (Column 2, lines 55 – 57) wherein, when an adhesive force for adhering the peeling sheet to the adhesive film of the cover sheet is indicated by AP_1 and an adhesive force for adhering the protective sheet to the resin film of the cover sheet is indicated by AP_2 , the peeling sheet is adhered to the adhesive film of the cover sheet and the protective sheet is adhered to the resin film of the cover sheet so that the relationship AP_1 less than or equal to AP_2 is satisfied by the release coating that is formed on the liner material (Column 3, lines 54 – 57) as in claim 1. With regard to claim 3, the cover sheet, the resin film and adhesive film, has a total thickness that ranges from 13 micrometers to 300 micrometers (Column 2, lines 43 – 45; Column 3, lines 46 – 48). The peeling material includes a silicone coated on the attaching surface of the peeling sheet (Column 3, lines 66 – 67), and the adhesive

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material includes a vinyl acetate coated on an attaching surface of the protective sheet (Column 3, lines 15 – 17) as in claims 10 and 11. However, Shigetomi et al. fails to disclose the thin film cover sheet being adhered via the adhesive film to a recording surface of a disk substrate, the adhesive force AP_1 is set to be a value selected from a range of 5 to 50 g/cm and the adhesive force is set to be a value selected from a range of $(AP_1 * 1.0)$ to $(AP_1 * 3.0)$.

Liu et al. teach the thin film cover sheet being adhered via the adhesive film, repositionable adhesive, to a recording surface of a disk substrate (Page 2, Paragraph 0037, lines 1 – 5), the adhesive force AP_1 is set to be a value selected from a range of 5 to 50 g/cm (Page 9, claims 3 and 4), and the adhesive force is set to be a value selected from a range of $(AP_1 * 1.0)$ to $(AP_1 * 3.0)$ (Page 3, Paragraph 0042) for the purpose of using adhesive coated articles to economically, efficiently and safely pack, store, clean, protect, organize and index optical recording media (Page 1, Paragraph 0002, lines 1 – 3).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the difference in adhesive force of the adhesive layer to different surfaces in Shigetomi et al. in order to use adhesive coated articles to economically, efficiently and safely pack, store, clean, protect, organize and index optical recording media as taught by Liu et al.

Response to Arguments

9. Applicant's arguments filed January 26, 2006 with regard to the 35 U.S.C. 103 rejection have been fully considered but they are not persuasive.

10. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The applicant refers to the hard coat layer not being an essential element of the disk of Shigetomi et al and the reading/recording surface of the an optical disk not being a structural element of Liu et al. The Examiner is unclear how this relates to the cover sheet package.

11. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the protective sheet being peeled off the cover sheet package) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

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generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Shigetomi et al. teaches the use of the same type of adhesive to adhere the label to the surface of the disk as claimed by the Applicant (Column 3, lines 15 – 17), thereby resulting in different adhesive forces.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer
Examiner
Art Unit 1772

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Harold Pyon
HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

3/14/03